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ID

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/464,099

12/16/99

BARRY

G

MOBT:175-2

HM12/1004

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EXAMINER

EWOLDT, G

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

10/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/464,099

Applicant(s)

Barry et al.

Examiner

Gerald Ewoldt

Group Art Unit

1644

☒ Responsive to communication(s) filed on Jun 19, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 100-104 and 107 is/are pending in the application.

Of the above, claim(s) 100 and 101 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 102-104 and 107 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 and 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Applicant's election of Group I (claims 100-104 and 107) and the species SEQ ID NO:3, in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 105 and 106 have been canceled.

3. Claims 100 and 101 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to nonelected species.

4. Claims 102-104 and 107 are being acted upon.

5. The disclosure is objected to because of the following informalities

The repeated use of the trademarks AMICON®, SEPHAROSE®, and MONO-Q® have been noted in this application. Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 102-104 and 107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claims 102-104 are indefinite in that they depend on non-elected claim 101 (which has been renumbered as claim 100).

B) Claims 102-104 are indefinite in the recitation of the term "sequence domains" (in claim 100); said term has no specific meaning in the art and thus renders the claims indefinite.

C) Claims 102-104 and 107 are indefinite in the repeated recitation of the word "the"; proper usage comprises the word "said" to refer to a specific antecedent.

8. The specification as filed includes a first paragraph that has been crossed out. The deletion was apparently made in the parent application 09/137,440. A first line claiming priority to parent application 09/137,440, filing date 8/20/98, was inserted in the instant application by preliminary amendment a. Thus, the priority date of the instant application is the filing date of the parent application, 8/20/98. Note that parent application 09/137,440 was filed after the abandonment dates of both 07/749,611 (abandoned 10/17/94) and 07/576,537 (abandoned 4/6/92) to which it claims priority. Thus 09/137,440 could not properly claim priority to either 07/749,611 or 07/576,537 because continuity was not maintained.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 102-103 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 92/04449 (1992).

WO 92/4449 teaches an anti 5-enolpyruvylshikimate-3-phosphate synthase antibody (see particularly page 53, line 17) that would bind the elected species, SEQ ID NO:3.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 104 and 107 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 92/04449 (1992).

WO 92/4449 teaches an anti 5-enolpyruvylshikimate-3-phosphate synthase antibody (see particularly page 53, line 17). The reference does not specifically teach a monoclonal antibody or the packaging of the claimed antibody in a kit. However, the usefulness of monoclonal, chimeric, humanized, or bispecific antibodies and/or fragments thereof, with respect to their specificity of binding, their homogeneity and/or their ability to


be produced in unlimited quantities, was well known in the art at the time the invention was made. Additionally, the packaging of an antibody in a kit comprising a container and a detection agent was well known in the art and accepted as normal practice for convenience.

15. No claim is allowed.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday and alternate Fridays from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

G.R. Ewoldt, Ph.D.
Patent Examiner
Technology Center 1600
September 29, 2000


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